



12/19/03

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PTO/SB/21 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

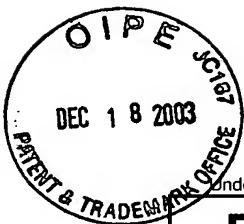
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| | | | |
|---|----------------------|------------------------|------------------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/727,177 | |
| | Filing Date | December 3, 2003 | |
| | First Named Inventor | Mary C. Tannenbaum | |
| | Art Unit | N/A | |
| | Examiner Name | Not Yet Assigned | |
| Total Number of Pages in This Submission | 107 | Attorney Docket Number | 005708/P010US/08008819 |

| ENCLOSURES (Check all that apply) | | |
|---|--|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition to Make Special <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Statement in Support of Petition to Make Special Copy of Information Disclosure Statement and PTO/SB/08A 6 Cited References |
| Remarks | | |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | |
|--|--|
| Firm or Individual name | FULBRIGHT & JAWORSKI L.L.P. David M. Tannenbaum |
| Signature | |
| Date | December 18, 2003 |

| Transmittal | |
|---|----------------------------|
| I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 256036077 US, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below. | |
| Dated: December 18, 2003 | Signature: (Donna Forbit) |



PTO/SB/17 (10-03)
Approved for use through 7/31/2006. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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FEE TRANSMITTAL for FY 2004

Effective 10/01/2003, Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$) 130.00

Complete if Known

| | |
|----------------------|------------------------|
| Application Number | 10/727,177 |
| Filing Date | December 3, 2003 |
| First Named Inventor | Mary C. Tannenbaum |
| Examiner Name | Not Yet Assigned |
| Art Unit | N/A |
| Attorney Docket No. | 005708/P010US/08008819 |

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit Card ☐ Money Order ☐ Other ☐ None

☐ Deposit Account:

Deposit
Account
Number

06-2380

Deposit
Account
Name

Fulbright & Jaworski L.L.P.

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☒ Credit any overpayments

☒ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description | Fee Paid |
|----------|----------|----------|----------|------------------------|----------|
| 1001 | 770 | 2001 | 385 | Utility filing fee | |
| 1002 | 340 | 2002 | 170 | Design filing fee | |
| 1003 | 530 | 2003 | 265 | Plant filing fee | |
| 1004 | 770 | 2004 | 385 | Reissue filing fee | |
| 1005 | 160 | 2005 | 80 | Provisional filing fee | |

SUBTOTAL (1) (\$) 0.00

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

| Total Claims | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------|----------------|----------|
| 51 | -51** = | | 0.00 |
| Independent Claims | 5 | -5** = | 0.00 |
| Multiple Dependent | | | |

Large Entity Small Entity

| Fee Code | Fee (\$) | Fee Code | Fee (\$) | Fee Description |
|----------|----------|----------|----------|--|
| 1202 | 18 | 2202 | 9 | Claims in excess of 20 |
| 1201 | 86 | 2201 | 43 | Independent claims in excess of 3 |
| 1203 | 290 | 2203 | 145 | Multiple dependent claim, if not paid |
| 1204 | 86 | 2204 | 43 | ** Reissue independent claims over original patent |
| 1205 | 18 | 2205 | 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$) 0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

| Large Entity Fee Code | Large Entity Fee (\$) | Small Entity Fee Code | Small Entity Fee (\$) | Fee Description | Fee Paid |
|-----------------------|-----------------------|-----------------------|-----------------------|--|----------|
| 1051 | 130 | 2051 | 65 | Surcharge - late filing fee or oath | |
| 1052 | 50 | 2052 | 25 | Surcharge - late provisional filing fee or cover sheet. | |
| 1053 | 130 | 1053 | 130 | Non-English specification | |
| 1812 | 2,520 | 1812 | 2,520 | For filing a request for ex parte reexamination | |
| 1804 | 920* | 1804 | 920* | Requesting publication of SIR prior to Examiner action | |
| 1805 | 1,840* | 1805 | 1,840* | Requesting publication of SIR after Examiner action | |
| 1251 | 110 | 2251 | 55 | Extension for reply within first month | |
| 1252 | 420 | 2252 | 210 | Extension for reply within second month | |
| 1253 | 950 | 2253 | 475 | Extension for reply within third month | |
| 1254 | 1,480 | 2254 | 740 | Extension for reply within fourth month | |
| 1255 | 2,010 | 2255 | 1,005 | Extension for reply within fifth month | |
| 1401 | 330 | 2401 | 165 | Notice of Appeal | |
| 1402 | 330 | 2402 | 165 | Filing a brief in support of an appeal | |
| 1403 | 290 | 2403 | 145 | Request for oral hearing | |
| 1451 | 1,510 | 1451 | 1,510 | Petition to institute a public use proceeding | |
| 1452 | 110 | 2452 | 55 | Petition to revive - unavoidable | |
| 1453 | 1,330 | 2453 | 665 | Petition to revive - unintentional | |
| 1501 | 1,330 | 2501 | 665 | Utility issue fee (or reissue) | |
| 1502 | 480 | 2502 | 240 | Design issue fee | |
| 1503 | 640 | 2503 | 320 | Plant issue fee | |
| 1460 | 130 | 1460 | 130 | Petitions to the Commissioner | 130.00 |
| 1807 | 50 | 1807 | 50 | Processing fee under 37 CFR 1.17(q) | |
| 1806 | 180 | 1806 | 180 | Submission of Information Disclosure Stmt | |
| 8021 | 40 | 8021 | 40 | Recording each patent assignment per property (times number of properties) | |
| 1809 | 770 | 2809 | 385 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 1810 | 770 | 2810 | 385 | For each additional invention to be examined (37CFR 1.129(b)) | |
| 1801 | 770 | 2801 | 385 | Request for Continued Examination (RCE) | |
| 1802 | 900 | 1802 | 900 | Request for expedited examination of a design application | |

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 130.00

SUBMITTED BY

Name (Print/Type) David H. Tannenbaum

Registration No.
(Attorney/Agent)

24,745

(Complete (if applicable))

Telephone (214) 855-8333

Signature

Date

December 18, 2003

Fee Transmittal

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 256036077 US, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: December 18, 2003

Signature:

Donna Forbit

(Donna Forbit)

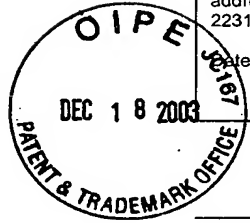
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Dated: December 18, 2003

Signature:

Donna Forbit
(Donna Forbit)

Docket No.: 005708/P010US/08008819
(PATENT)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mary C. Tannenbaum

Application No.: 10/727,177

Confirmation No.: N/A

Filed: December 3, 2003

Art Unit: Not Yet Assigned

For: TIME-CONTROLLED MESSAGING
SYSTEM

Examiner: Not Yet Assigned

**PETITION TO MAKE SPECIAL
UNDER 37 C.F.R. § 1.102 AND M.P.E.P. § 708.02 (VIII)**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby petitions to make this application, as amended by the accompanying Preliminary Amendment, special for accelerated examination pursuant to 37 C.F.R. § 1.102(d) and M.P.E.P. § 708.02 (VIII)

Accompanying Material

Accompanying this petition is:

1. A Statement in Support of Petition to Make Special in accordance with M.P.E.P. § 708.02 (VIII)(C) and (E);
2. The fee as required by 37 C.F.R. § 1.17(h) being paid by the enclosed check in the amount of \$130.00;
3. An IDS disclosing the references found during a preliminary patentability search was filed with the application (a copy of which is attached hereto); and
4. Agreement to make an Election of a single invention.

12/24/2003 YPOLITE1 00000042 10727177

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130.00 0P

Dated: December 18, 2003

Respectfully submitted,

By 

David H. Tannenabum

Registration No.: 24,745

FULBRIGHT & JAWORSKI L.L.P.

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(214) 855-8333

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Attorney for Applicant



I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV256036077US, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: December 18, 2003

Signature: Donna Forbit

(Donna Forbit)

Docket No.: 005708/P010US/08008819
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Mary C. Tannenbaum

Application No.: 10/727,177

Filed: December 3, 2003

For: TIME-CONTROLLED MESSAGING
SYSTEM

Confirmation No.: N/A

Art Unit: Not Yet Assigned

Examiner: Not Yet Assigned

STATEMENT IN SUPPORT OF PETITION TO MAKE SPECIAL M.P.E.P. § 708.02 (VIII) (C) and (E)

Applicant hereby requests that the above-identified patent application be made special for accelerated examination pursuant to C.F.R. § 1.102(d) and M.P.E.P. § 708.02(VIII). Applicant submits herewith a petition to make special and the fee set forth in 37 C.F.R. § 1.17(h) in accordance with M.P.E.P. § 708.02(VIII)(A).

Further, in accordance with M.P.E.P. § 708.02(VIII)(C), a pre-examination search has been made for this application. The most relevant search areas searched was U.S. Patent **Class 709, subclass 206**. Also, searches were made using the keywords: Telephone and Answering and machine and time; time-controlled and messaging.

The search resulted in discovery of the following references that are deemed most closely related to the subject matter encompassed by the claims:

| | |
|------------------|-----------|
| Malkin et al. | 6,643,684 |
| Schiller et al. | 6,442,573 |
| Kohler | 6,192,396 |
| Henderson et al. | 6,185,603 |
| Adamczyk et al. | 6,650,740 |

An Information Disclosure Statement has been submitted with the application that identifies and includes a copy of each of the above references, in accordance with 37 C.F.R. §1.56 and M.P.E.P. §708.02(VIII)(D).

If accelerated examination is granted, applicant agrees to make an election of a single invention without traverse if the examiner determines that all of the claims are not obviously directed to a single invention.

DETAILED DISCUSSION OF REFERENCES

In accordance with M.P.E.P. § 708.02(VIII)(E), Applicant provides the following descriptions and detailed discussion of the above-identified references, pointing out with particularity how the claimed subject matter is patentable over such references.

1. 6,643,684 Malkin et al.

The Malkin patent teaches the association of attributes (policies) to various messages for the purpose of controlling the electronic delivery and/or distribution, including the delivery time, of the associated message. In the context of Malkin, the delivery of the message is to one or more pieces of equipment (or systems) at the recipient's location. Malkin does not teach the playing, or actual displaying of the message as specifically claimed in the application

Thus, Claim 1 recites... "a clock for playing each received message at the controlled play time associated with said received message."

Claim 19 recites... "providing over an established communication connection a message playing time for a message to be played to said receiving party at said message playing time."

Claim 28 recites ... "said processor further operable for controlling the playback of said message in accordance with said attributes and wherein at least one of said attributes is a time of said playback"

Claim 37 recites ... "a clock for enabling stored ones of said messages to be played to a recipient without action on the part of said recipient"

Claim 37 further recites that additional data obtained at the time the message is played can be added to the message. Claim 44 recites ... "playing each said stored message for said

recipient at said time associated with said stored message without action taken by said recipient, at the time each said message is played.”

Malkin does not in any way teach the concepts claimed in the instant application.

2. 6,442,573 Schiller et al.

Schiller teaches the concept of downloading data directly to a display without requiring the recipient to perform a function in order to obtain the data. In Schiller, the data is stored on a server and at a preset time the display “calls” the server and the server downloads the data. As discussed above with respect to Malkin, Claims 1, 19, 28 and 44 all recite that the time for a message to be played is associated with that message. In Schiller, the time for playing the message or messages is contained in association with the message. Claim 37 does not recite that the time for the message to play is associated with the message.

However, Claim 37 also recites .. “a processor for controlling the addition of data to any stored message, said added data obtained at the time said message is played”.

Schiller does not in any manner teach the concepts claimed in the instant application.

3. 6,192,396 Kohler

Kohler teaches a messaging system where the each message can have recipient specific content. In addition, in Kohler, the viewer can set options for viewing the message. This patent is cited for background purposes only because at first reading it appeared pertinent to a claimed feature. The Kohler patent is not more relevant than the patents discussed above.

4. 6,185,603 Henderson et al.

Hendersen teaches a messaging system that uses the subject line of a message to determine where the message is to be delivered and the appearance of the message when it is delivered. As taught by Henderson, the control codes are directed to alerting messages. Henderson does not adjust the point size of the display nor do the codes change text messages to graphical messages as claimed.

5. 6,650,740 Adamczyk et al.

Adamczyk teaches a system for enabling a subscriber to reply to voice mail messages. The concept of controlling the reply to a message played for a recipient is contained in some of the dependant claims of the application as filed. The Adamczyk patent is cited for background purposes only because at first reading it appeared pertinent to a claimed feature. The Adamczyk patent is not more relevant than the patents discussed above.

6. Readers Digest Advertisement, December 2003, (obtained in late November), page 22

The advertisement is for a child's toy (pager) that contains a wireless recorder that links absent parents to their children. The parent can call the device (not specified as to how) and leave a message. The toy lights up to signify that the toy has mail. The child can then listen to the message. The toy acts as a typical answering machine would in that it accepts a message directed to it and then, on command of the recipient, it plays the message.

As discussed above, the Claims of the application call for the message to be played to the recipient without the recipient taking action or played for the recipient at a time controlled by the sender of the message.

The Readers Digest advertisement is not more pertinent to the claims than the patents discussed above.

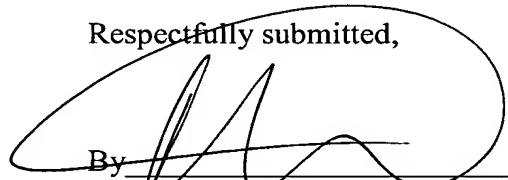
Conclusion

As shown above, there are important differences between the independent claims and the most relevant art found in Applicant's pre-examination search. Moreover, as pointed out above, a person of ordinary skill in the art considering the art found would not find these differences obvious. Accordingly, Applicant respectfully asserts that claims 1-51 are allowable over the art found in Applicant's pre-examination search. Therefore, Applicant respectfully requests that this application be granted special status for expedited prosecution and that this application be passed to issue.

Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Dated: December 18, 2003

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David H. Tannenbaum', is written over a horizontal line. The signature is enclosed within a large, hand-drawn oval.

By David H. Tannenbaum
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